

REMARKS

Claims 1-15 are pending, of which, claims 1 and 2 are independent.

Referring to page 2 of the Office Action, claims 1-6 and 9-15 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2003/0124259 ("Kodas").

Referring to page 4 of the Office Action, claims 7-8 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kodas.

Applicants traverse and respectfully request the Examiner to reconsider in view of the following remarks.

Claims 1 and 2 recite in relevant part a conductive composition comprising a particulate silver compound and a binder, wherein the quantity of the binder used relative to 100 parts by weight of the particulate silver compound is within a range of from 0.78 to 2.36 parts by weight.

By employing an amount of binder within the recited range, a conductive composition achieves the unique effects disclosed in the present specification, such as that the "metallic silver particles melt and fuse together" and that "the binder either fills the gaps in woven structure of the silver particles, or covers the surface of the coating, or fills in the gaps in the silver coating and the target surface." See page 9 of the present specification at line 14 and lines 16-18. Therefore, the presently recited conductive composition is capable of producing, for example, a conductive paint with a low volume resistivity and a high conductivity that is comparable to that of metallic silver.

The Examiner is of the opinion that the amount of binder employed in specific examples disclosed by Kodas ranged from 0.83-2.2 parts of cellulose per 100 grams of the silver salt. See

the sentence bridging pages 2-3 of the Office. Thus, the Examiner takes the position that this would meet the binder ratio limitations in present claims 1 and 2.

Applicants respectfully submit that the Examiner has miscalculated the amount of binder in the examples of Kodas.

In Example 20 of Kodas at paragraph [0273], the reference employs a mixture of 80g of metallic silver powder and 10g of silver trifluoroacetate : 0.1g of ethyl cellulose = 90 : 0.1. This defines the ratio as 100 : 0.11.

In Example 21 of Kodas at paragraph [0274], the reference employs a mixture of 80g of metallic silver powder, 9g of silver trifluoroacetate and 1g of palladium acetate : 0.2g of ethyl cellulose = 90 : 0.2. This defines the ratio as 100 : 0.22.

In Example 22 of Kodas at paragraph [0275], the reference employs a mixture of 80g of metallic silver powder, 9g of silver trifluoroacetate and 1g of palladium acetate : 0.2g of ethyl cellulose = 90 : 0.2. This defines the ratio as 100 : 0.22.

In Example 27 of Kodas at paragraph [0280], the reference employs a mixture of 54.5g of silver/silica composite powder and 6g of silver trifluoroacetate : 0.05g of ethyl cellulose = 60.5 : 0.05. This defines the ratio as 100 : 0.083.

Accordingly, the amount of a binder in the examples of Kodas cited by the Examiner actually ranged from 0.083-0.22 parts of cellulose per 100 parts by weight of the silver salt.

In contrast, present independent claims 1 and 2 require the amount of binder used relative to 100 parts by weight of particulate silver compound to be within a range of from 0.78 to 2.36 parts by weight. Therefore, the composition of Kodas is significantly different from conductive metal composition of present claims 1 and 2. Furthermore, even if a *prima facie* case of obviousness could be established, it would be rebutted by the superior results shown in Tables

2A and 2B at page 14 of the originally filed specification that were obtained when a binder was employed within the recited range. These results would have been unexpected in view of the disclosure of Kodas, since the reference provides no express guidance regarding the binder ratio limitation to a person of ordinary skill in the art, outside of the specific examples disclosed therein.

Applicants submit that for *at least* the reasons above, Kodas fails to anticipate or render obvious the subject matter of independent claims 1 and 2.

In view of the above, Applicants respectfully request reconsideration and withdrawal of the §102 rejection of claims 1-6 and 9-15 and the §103 rejection of claims 7-8, both based on the disclosure of Kodas.

Referring to page 5 of the Office Action, claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 4-10 and 14-24 of copending Application No. 10/500,124 - as amended on August 16, 2007 - in view of Kodas.

Since this rejection is provisional, Applicants defer response to the rejection at this time.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116
Application No.: 10/510,512

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